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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,194	10/16/2003	Vilho Nissinen	3397-94DV4	7128
7590 Michael C. Stuart Cohen, Pontani, Lieberman & Pavane Suite 1210 551 Fifth Avenue New York, NY 10176			EXAMINER HALPERN, MARK	
			ART UNIT	PAPER NUMBER
			1791	
			MAIL DATE	DELIVERY MODE
			05/19/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/687,194

**Applicant(s)**

NISSINEN ET AL.

**Examiner**

Mark Halpern

**Art Unit**

1791

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 62-64 is/are pending in the application.
- 4a) Of the above claim(s) 63 and 64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CI/CD)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 1/28/08

### **DETAILED ACTION**

1) In view of the Appeal Brief filed on 1/23/2008, PROSECUTION IS HEREBY REOPENED. Office Action is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2) Claim 62 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 62 is a non-statutory claim since it includes the **USE** and the **METHOD OF MAKING** of recycled calcium carbonate. Claims 62 part "A use of recycled calcium carbonate in the treatment of a paper, board or nonwoven product, comprising: treating the paper, board, or nonwoven product with the recycled calcium carbonate," pertains to the use of recycled calcium carbonate. Claim 62 part "the recycled calcium carbonate being prepared by calcining into lime precipitated calcium carbonate residue of a deinking process of recycled fiber of the paper, board or non-woven product; reacting the lime with water to form calcium hydroxide; and reacting the calcium hydroxide with carbon dioxide to form the recycled calcium carbonate." pertains to the method of making recycled calcium carbonate.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

- 3) Claim 62 is rejected under 35 U.S.C. 102(b) as being anticipated by Sohara (5,759,258). Sohara discloses the forming of calcium carbonate from residues of deinking of wastepaper process, as shown in Figure 1. The formed recycled calcium carbonate also known as precipitated calcium carbonate (PCC) is used for treatment of paper, for example, to provide high brightness to the paper as disclosed in Example I (cols. 6-7).

Art Unit: 1791

Note: Claim 62 part "the recycled calcium carbonate being prepared by calcining into lime precipitated calcium carbonate residue of a deinking process of recycled fiber of the paper, board or non-woven product" pertains to the method of making the recycled calcium carbonate and does not pertain to the use of the recycled calcium carbonate.

Claims 62 part "A use of recycled calcium carbonate in the treatment of a paper, board or nonwoven product, comprising: treating the paper, board, or nonwoven product with the recycled calcium carbonate," pertains to the use of recycled calcium carbonate.

Sohara discloses recycled calcium carbonate, also known as precipitated calcium carbonate (PCC), is used for treatment of paper, for example, to provide high brightness to the paper as disclosed in Example I, regardless as to how the recycled calcium carbonate is formed.

4) Claim 62 is rejected under 35 U.S.C. 102(b) as being anticipated by Virtanen (WO 98/16471). Virtanen discloses the forming of calcium carbonate (Pgs. 6-7, Examples 1-2, Pgs. 15 and Pg. 16, lines 15-25). The formed recycled calcium carbonate also known as precipitated calcium carbonate (PCC) is used for treatment of paper, for example, to provide opacity and brightness to the paper (Pg. 1 lines 10-29).

### ***Conclusion***

5) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone number is 571-272-1190. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

/Mark Halpern/  
Primary Examiner  
Art Unit 1791

**Serial Number**



**Application No.**

10/687,194

**Applicant(s)**

NISSINEN ET AL.

**Examiner**

Mark Halpern

**Art Unit**

1791